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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/848,834	05/17/2004	Thomas J. Bachinski	12929.1077USCI	4798
7590	09/07/2005		EXAMINER	
Robert A. Kalinsky MERCHANT & GOULD P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			BASICHAS, ALFRED	
			ART UNIT	PAPER NUMBER
			3749	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/848,834	BACHINSKI ET AL.
	Examiner Alfred Basichas	Art Unit 3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 26-33 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 26-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 26, 28, 29, 31, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell (6,216,687), which shows all of the claimed limitations. Campbell shows a gas-burning fireplace including substantially all of the claimed limitations, such as an air heating conduit 46,48,50, a blower 72, and a filter 90 (actually a catalyst but also acts as a filter – see at least col.7, lines 51-54).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 26, 28, 29, 31, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell (6,216,687) in view of Myrick (6,666,206). Campbell discloses at least substantially all of the claimed limitations as discussed above. Nevertheless, if the claims are read more narrowly, it may be argued that the "intake air" does not relate to the intake air entering from the combustion chamber. Myrick however teaches a plenum 10 providing a similar function as that of the instant invention in which a filter 42 is specifically provided at the intake of the plenum so as to keep debris, such as ash and dust, from entering the plenum (see at least col. 4, lines 19-36). While

Myrick teaches an outtake filter as well, this does not detract nor make unobvious the use of the intake filter alone. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the filter as taught by Myrick into the invention disclosed by Campbell, so as to keep debris from entering the plenum.

7. Claims 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell (6,216,687) in view of Morrow (5,656,242) or Campbell (6,216,687) in view of Myrick (6,666,206) and further in view of Morrow (5,656,242). Campbell and Campbell in view of Myrick disclose substantially all of the claimed limitations as discussed above, but do not specifically disclose UV sterilization or ion generation for further air purification. Morrow teaches an air purifier device including, among porous filters, UV sterilization 44 and electrostatic filter 18 in order to purge the air of contaminants. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the UV and electrostatic filtering taught by Morrow into the inventions disclosed by Campbell or Campbell in view of Myrick, so as to effectively purge the air of contaminants.

Response to Arguments

8. Applicants' arguments with regard to the rejected claims, filed July 21, 2005, have been considered, but are not deemed fully persuasive.

- a. Applicant asserts that Campbell fails to anticipate the claimed limitation because the filter is exposed to air from inside the firebox. Nevertheless, the fact

that the filter of Campbell exhibits a function *in addition to* that which is claimed, specifically that air from the room that remains in the plenum and does not flow through the firebox, does not detract from the fact that the claimed limitations are shown. Applicant's attention is directed to at least fig. 6, which shows a number of passages within the plenum, not least of which, passage 134. Applicant is further reminded that the claim language does not include the term "consisting", but rather recites comprising. Therefore, additional structure and function of the prior art does not exclude it from anticipating the claimed invention.

b. Applicant asserts that Myrick fails to remedy the alleged deficiencies of Campbell because the insert is not a plenum as envisioned by applicant's invention. Nevertheless, a broad interpretation of plenum includes the insert taught by Myrick. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, in anticipation of applicant asserting that the insert cannot be read on a plenum because it is not integral with the housing of the fireplace, it has been held that where constituent parts are combined so as to constitute a unitary whole, the unitary whole is deemed integral. *In re Larson*, 144 USPQ 347.

c. Finally, applicant asserts that Myrick cannot obviate the claimed invention because it has another function. This is simply not correct. Regardless of the additional function that the filter of Myrick can provide, it is still capable of

performing the claimed function. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 571 272 4871. The examiner can normally be reached on Monday through Friday during regular business hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 571 272 4877. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center telephone number is 571 272 3700.

August 31, 2005



Alfred Basichas
Primary Examiner